

REMARKS

The Office Action dated June 15, 2004, has been received and reviewed.

Claims 1-23 are currently pending and under consideration in the above-referenced application, each standing rejected.

Reconsideration of the above-referenced application is respectfully requested.

Preliminary Amendment

Please note that a Preliminary Amendment was filed in the above-referenced application on March 4, 2004, but that the undersigned attorney has not yet received any acknowledgement that the Preliminary Amendment has been entered into the Office file for the above-referenced application. If, for some reason, the Preliminary Amendment has not yet been entered into the Office file, the undersigned attorney would be happy to provide the Office with a true copy thereof.

Rejections Under 35 U.S.C. § 102(b)

Claims 1-12 stand rejected under 35 U.S.C. § 102(b) for reciting subject matter which is assertedly anticipated by the subject matter described in U.S. Patent 5,667,541 to Klun et al. (hereinafter "Klun").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Klun describes processes for forming abrasive articles and apparatus that includes use of polymers that may be cured by use of free radicals.

Independent claim 1 is directed to a method for fabricating an apparatus for conditioning a polishing pad. The method of independent claim 1 includes, among other things, providing a quantity of an abrasive material that is degradable or dissolvable by at least one chemical that does not substantially degrade or dissolve a material of a polishing pad to be conditioned with the

apparatus. Additionally, the method of independent claim 1, as amended and presented herein, includes “forming a conditioning surface that includes at least a portion of the quantity of abrasive material, the conditioning surface including a plurality of abrasive elements and configured to condition a polishing pad for use in semiconductor device fabrication processes.”

It is respectfully submitted that there are at least two reasons that Klun does not anticipate each and every element of independent claim 1.

First, Klun lacks any express or inherent description of providing an abrasive material that is “degradable or dissolvable by at least one chemical that does not substantially degrade or dissolve a material of a polishing pad to be conditioned with [an] apparatus” of which the abrasive material is to be a part. While Klun mentions some materials that might be degradable or dissolvable by at least one chemical that will not substantially degrade or dissolve a material of a polishing pad, including quartz, silica, and glass (col. 18, lines 53-63), Klun does not expressly or inherently describe that any of these materials may be used to fabricate an apparatus for conditioning a polishing pad.

Moreover, many of the materials that Klun lists as being useful as abrasives in forming abrasive articles are the types of materials that the above-referenced application mentions are undesirable for use in conditioning polishing pads. In particular, Klun notes that diamond, corundum, alumina, and silicon carbide are useful as abrasives in articles that are manufactured in accordance with the techniques that are described in Klun. Col. 18, lines 53-63.

Second, Klun does not expressly or inherently describe “forming a conditioning surface . . . that [is] configured to condition a polishing pad for use in semiconductor device fabrication processes.” Instead, Klun quite vaguely describes that various types of abrasive articles may be formed in accordance with the techniques that are described therein.

For these reasons, it is respectfully submitted that Klun does not anticipate each and every element of amended independent claim 1, as would be required to maintain the rejection thereof under 35 U.S.C. § 102(b).

Each of claims 2-12 is allowable, among other reasons, for depending either directly or indirectly from claim 1, which is allowable.

Claim 10 is additionally allowable because Klun neither expressly nor inherently describes forming a supporting substrate from a quantity of abrasive material.

In view of the foregoing, it is respectfully requested that the 35 U.S.C. § 102(b) rejections of claims 1-12 be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Claims 13-23 are rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Klun in View of Bange

Claims 14-23 have been rejected under 35 U.S.C. § 103(a) for reciting subject matter which is purportedly unpatentable over teachings from Klun, in view of the subject matter taught in U.S. Patent 6,352,471 to Bange et al. (hereinafter "Bange").

Claims 14-23 are each allowable, among other reasons, for depending either directly or indirectly from claim 1, which is allowable.

Klun in View of Proffitt

Claim 13 has been rejected under 35 U.S.C. § 103(a) for reciting subject matter that is purportedly unpatentable over teachings from Klun, in view of the teachings of U.S. Patent 4,232,059 to Proffitt (hereinafter "Proffitt").

In addition to being allowable for depending indirectly from claim 1, claim 13 is allowable because the teachings of Klun and Proffitt do not support a *prima facie* case of obviousness against the subject matter recited in claim 13. This is because one of ordinary skill in the art would not have been motivated to combine the teachings of Klun and Proffitt in the manner that has been asserted. More specifically, the teachings of Klun and Proffitt are from nonanalogous arts—the teachings of Klun relate to the art of polymers that are useful in manufacturing abrasive articles, while the teachings of Proffitt relate to methods for masking and patterning semiconductor devices. Although Proffitt teaches that such masks may be used with air-abrasion processes, the processes that are described in Proffitt have nothing to do with forming abrasive articles.

Based on the disparity between the teachings of Klun and those of Proffitt, it appears the only source of motivation to combine the teachings of these references would have been the subject matter disclosed and claimed in the above-referenced application.

Withdrawal of the 35 U.S.C. § 103(a) rejections of claims 13-23 is respectfully requested.

CONCLUSION

It is respectfully submitted that each of claims 1-23 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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